



UNITED STATES
PATENT AND
TRADEMARK OFFICE

UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY
AND DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE
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BRENDA HERSCHBACH JARRELL
CHOATE HALL & STEWART
EXCHANGE PLACE
53 STATE STREET
BOSTON, MA 02109-2891

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In re Application of :
Howard B. Sosin et al :
Serial No.: 09/290,029 : PETITION DECISION
Filed: April 9, 1999 :
Attorney Docket No.: 3238897 :

This is in response to applicants' petition under 37 CFR 1.181, filed April 9, 2001, requesting withdrawal of finality of an Office action.

A review of the file history shows that this application was filed April 9, 1999, and contained claims 1-281. On March 3, 2000, the examiner mailed a restriction requirement to applicants dividing the claims into 40 different groups and requiring, depending on which group was elected, an election of species within the group. Applicants replied on April 6, 2000, electing Group 14, and the species of oligonucleotides containing CpG motifs as a specific factor encompassing a specific antigen, targeting agent, a dendritic cell as a specific pAPC and a liposome as a specific encapsulating device (claims 50-55, 60-61, 63-69, 79-98, 102-112, 115-117, 122-123, 125-127, 129, 136-157, 160-176 and 184-193) with traverse. The examiner treated the election as an election without traverse since no arguments for traversal were presented. The examiner also rejected the claims under 35 U.S.C. 112, second paragraph, and 35 U.S.C. 103(a) over various references.

Applicants replied on September 25, 2000, by amending claims 50, 89, 108, 116 and 161, and traversing the rejections of record. The amendment changed the preamble of at least some claims from "A method of modulating an immune response to an antigen..." to "A method of modulating presentation of an antigen..." The examiner then stated that claims 50-55, 60, 63-66, 79-81, 84-91, 94-97, 102-104 and 108, as amended, were now directed to an invention independent and distinct from the originally elected invention and were therefor withdrawn from consideration. The remaining claims were acted on and rejected under 35 U.S.C. 112, second paragraph, and 35 U.S.C. 103(a) for the reasons of record. The action was made Final.

Applicants replied on April 9, 2001, by proposing amendments to various claims, including revising the preamble of some amended claims to read as originally presented (modulating an immune response). The amendment was not entered as other amendments were proposed in other claims which raised new issues, as set forth in an Advisory Action mailed April 25, 2001.

The petition requesting withdrawal of Finality was filed with the amendment, but was not forwarded for decision until now. Applicants filed a Notice of Appeal on June 4, 2001.

DISCUSSION

Applicants object to the withdrawal of the above identified claims under prosecution and making of the Office action Final. Applicants acknowledge amendment of the claims as stated above, but contend that the method steps remained unchanged and that the claim scope overall remained unchanged. Applicants further argue that even if there are small minor differences in claim scope they would not make the original and amended claims patentably distinct.

A consideration of the claims and the amendments has been made. It appears that the preamble of the claim is necessary to lend meaning, life and vitality to the claims, and therefor is an integral and important limitation to the claim scope. The difference between "manipulation (modulation) of an immune system" and "manipulating (manipulating) an antigen presentation" is significant. While antigen presentation is an immune function, it need not be. Search of the amended claim would have to be extended from Class 424, as originally determined, to Class 435. Based on the difference in classification and scope, withdrawal of the claims by the examiner as being to an invention non-elected by original presentation/election was proper. Finality of the Office action was predicated on the remaining claims being rejected for the same reasons as in the previous Office action. The examiner's action is not considered to be improper or incorrect. Had the subsequent amendment presented the withdrawn claims in their original form they would likely have been rejected for the reasons previously presented had been entered.

DECISION

Applicants' petition is **DENIED**.

Applicants remain under obligation to file an Appeal Brief within the time period specified in 37 CFR 1.192 or take other appropriate action.

Should there be any questions with respect to this decision, please contact William R. Dixon, Jr., by mail addressed to: Director, Technology Center 1600, Washington, D.C. 20231, or by telephone at (703)308-3824 or by facsimile transmission at (703) 305-7230..

Any request for reconsideration of this decision must be made within TWO MONTHS of the mailing date of this decision and should be addressed to the Office of Petitions.


Bruce M. Kisliuk
Director, Technology Center 1600